

Appl. No. 09/598,110
Amdt. dated November 1, 2006
Reply to Office action of 08/02/06

REMARKS/ARGUMENTS

Claim 6 is currently pending and is being amended with this response.

I. Rejection of Claim 6 under 35 U.S.C. § 103(a)

Claim 6 is currently rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable by U.S. Patent No. 4,192,500 (The “*Crow*” reference), the previous rejection by U.S. Patent No. 5,215,307 (the “*Huffman* reference”) now being removed. The rejection under the *Crow* reference is traversed.

A *prima facie* case of obviousness is established when one or more references that were available to the inventor and teach that a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Under M.P.E.P. § 706.02(j), three basic criteria must be met for the *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*,

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947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Additionally, prior art may be considered not to teach an invention and thereby may fail to support an obviousness rejection, particularly when the stated objectives of the prior art reinforce such an interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999).

The *Crow* reference teaches a racquet exercise device having two moveable hand elements, a spring assembly and weights. (See: Figs. 1-4). The shaft of the device positions the first hand element at a first end and positions the weights near the second end. Circular discs attach to the shaft by screws, nuts and a hook at a position on the shaft between the first hand element and the weights. (See: Column 4, lines 46-49). The second hand element pivotally attaches to the circular discs by screws and nuts. (See: Column 4, lines 46-49).

The spring assembly connects to the shaft via the hook and connects to the second hand element wherein the spring forces the first hand element and the second hand element apart. (See: Column 5, lines 34-39). The biasing force of the spring assembly can be adjusted. (See: Column 5, lines 35-45). The weights surround the shaft near the second end. Opposing collars and plates hold the weights on the shaft. (See: Column 4, lines 61-64). The weights can be adjusted along the shaft by loosening the collars. (See: Column 3, lines 1-2).

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During operation, the user adjusts the biasing force of the spring assembly to the desired resistance and positions the weights along the shaft. The user then grasps both the first hand element and the second hand element. (See: Column 5, lines 53-57). While squeezing first hand element and the second hand element toward each other, the user initiates tennis strokes. (See: Column 5, lines 56-62). The user may also swing the device without grasping the second hand element. (See: Figs. 1-2).

In contrast, claim 6 of the present application recites that the middle portion of the handle has a non-interrupted and uniform surface, i.e. a middle portion that is free from interferences between the first end and the second end. (See: Figs. 1-8). Additionally, the present claim recites that the weight is internally fastened to the second end. (See: Specification pages 4, lines 22-28, 5, lines 7-15 and 6, lines 28-30 and Figs. 1-8).

With respect to the teachings Mr. Pullaro's handle, a golf grip, for example, positions the hands of the user around the handle wherein the user's dominant hand partially overlaps the other hand. Since the handle has a uniform surface and allows uninterrupted access around the first end, the handle does not include any elements that interferes with the overlapped hands. The present invention allows the user to swing the device near the user's body as required during a golf swing.

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Under the teachings of the *Crow* reference, the circular discs, second hand element, spring assembly and associated screws and nuts are positioned on the shaft. Accordingly, the circular discs, second hand element and spring assembly as taught by the *Crow* reference would block any overlapping hands when the user grasps the first end. Further, the present invention teaches swinging the device near the body of the user. The extending circular discs and extending second handle prohibit swinging the shaft of the *Cross* reference near the body of the user since these components not only attach to the shaft but also extend outward from the shaft. (See: Figs. 1-4). Accordingly, the *Crow* reference teaches a non-uniform shaft. As emphasized, the racquet device of the *Crow* reference is used for tennis strokes, which are conducted away from the body.

Since the present application discloses the handle having a uniform middle portion, one skilled in the art would not be motivated to seek out the *Crow* reference due to the required extending components and objectives of the *Crow* reference. As decided by the Federal Circuit, a prior art reference was interpreted not to teach the claimed invention while using the stated objectives described in the prior art to reinforce the interpretation. *WMS Gaming Inc., v. International Game Tech.*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The *Crow* reference does not teach a suggestion or

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motivation to modify in order to achieve the present application. Accordingly, a prima facie case of obviousness has not been achieved.

Additionally, the *Crow* reference does not teach or suggest all of the present claim limitations such as the weight being internally fastened to the second end. In contrast, the *Crow* reference teaches attaching the weights to opposing collars. During repetitive swinging, however, these collars may slip leading to dangerous situations. The claimed feature of the present application internally fastens the weight to the second end eliminating additional components that may slip.

The analysis by the Examiner has not provided a prima facie case of obviousness. The Applicant respectfully requests the Examiner to comment on the Applicant's DVD presentation that was provided in a previous response. As noted in the DVD illustrating a prototype video relating to the application, the experts repeatedly assert that speed and power come from the forearms (See *also*: video presentation which highlights forearm strength exercises). Furthermore, as shown in the video presentation, the claimed features of the uniform middle portion and the single weight internally fastened at the second end allows the user to swing the device near the body of the user.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests

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that the Examiner withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office action, and as such, the present applicant is in condition for allowance.

Entrance of the amendment and passage of the case to issue are therefore respectfully requested. If the Examiner believes that personal communication will expedite prosecution of the application, the Examiner is invited to telephone the undersigned at (314) 238-2400.

Respectfully submitted, 

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